



# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

42390P11508

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on August 14, 2006.

Signature

*Julie Dussault*

Typed or printed  
name Julie Dussault

Application No.

09/851,725

Filed

May 8, 2001

First Named Inventor

Bernard Yeh

Art Unit

2144

Examiner

Greg C. Bengzon

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

NOTE: No more than five (5) pages may be provided.

I am the:

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under of 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ Attorney or agent of record.  
Registration Number 39,926
- ☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Signature

*Gregory D. Caldwell*

Typed or printed name

(503) 439-8778

Telephone Number

August 14, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required.

☐ \*Total of \_\_\_\_\_ forms are submitted.



*Mail Stop AF*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	09/851,725	Confirmation No. 3637
Inventor:	Yeh <i>et al.</i>	
Filed:	May 8, 2001	
Art Unit:	2144	
Examiner:	Bengzon, Greg C.	
Attorney Docket No.:	042390.P11508	
Customer No.:	25694	
For:	<b>Method and Apparatus for Measuring Performance of a Multi-Computer Communication Protocol on a Single Computer System</b>	

---

**Pre-Appeal Brief Request for Review**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action dated **May 12, 2006**, Applicants request review of the final rejection in the above-identified application. This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets, which begin on page 2 of this Request for Review. No amendments are being filed with this request.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to Deposit Account No. 02-2666.

***Request for Review***

Applicants are submitting this Request for Review because Applicants believe that there are clear errors in the Examiner's rejections. Applicants will clearly show that the Examiner has failed to establish a *prima facie* case of obviousness and that all the elements of the claims are not met by the references cited in the Final Office Action.

***Rejection under 35 U.S.C. § 103***

The Examiner, on page 2 of the Final Office Action, has rejected claims 1-6, 9-14, 17-20, and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,269,401 to Fletcher *et al.* (hereinafter "Fletcher") in view of U.S. Patent No. 5,636,371 to Yu. Applicants respectfully traverse this rejection. Based on the remarks set forth below, Applicants respectfully request that this rejection be reconsidered and withdrawn.

The Examiner has failed to establish a *prima facie* case of obviousness. Three criteria must be met to establish a *prima facie* case of obviousness. MPEP 2143. There must be some suggestion or motivation, either in the references themselves or in the knowledge available to one of skill in the art, to combine the references. *Id.* There must be a reasonable expectation of success. *Id.* And, lastly, the prior art references must teach or suggest all the claim limitations. *Id.* "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP 2143 (*citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness for at least the following reasons: (1) the references of Fletcher and Yu do not suggest the combination or motivate one skilled in

the art to combine them; and (2) Fletcher and Yu combined do not teach or suggest all of the claim limitations of independent claims 1, 3, 9, 11, 17, and 27.

As indicated above, the teachings or suggestions to combine must be found in Fletcher and Yu, not in Applicants' patent application. Fletcher teaches monitoring communication performance *in a communication network comprising communication systems communicatively coupled to each other with communication equipment.* *Fletcher*, Abstract; col. 3, lines 23-26; col. 3, lines 35-38; col. 6, lines 35-40. Thus, teachings of Fletcher require a client and a server as indicated by FIGs. 2-4.

Yu discloses "a method and system which enables application programs running [in] under control of different operating system components sharing a common communications protocol stack to utilize well-known ports for identifying like protocol application program services. *Yu*, col. 2, lines 49-54. Yu also discloses "a method and system for executing application programs which share a common communications protocol stack to utilize well-known port addresses for designating well-known application programs accessible by client application programs on a remote host system which is transparent to the remote system and requires minimal change to the host system thereby facilitating debugging, modifying and maintaining of such application programs." *Yu*, col. 2, lines 55-64.

Applicants submit that the Examiner has combined Fletcher and Yu based on Applicants' application disclosure. The Examiner's primary reference is Fletcher, which discloses monitoring communication performance in a communication network. The Examiner admits that Fletcher does not teach "a single computer system emulating a server and a client, said [single] computer executing server code and also executing client

code.” The Examiner then states that Yu teaches this feature. Applicants assert that the invention of Yu discloses executing programs that share a common communications protocol stack. Thus, there is nothing in the teachings of Fletcher (monitoring communication performance in a communication network) that would motivate one to combine it with the teachings of executing programs that share a common communications protocol stack as disclosed in Yu.

Furthermore, with respect to independent claims 1, 3, 9, 11, and 17, the Examiner states that Fletcher substantially teaches Applicants’ invention. Applicants respectfully disagree.

The Examiner, in setting forth this rejection, has acknowledged that Fletcher does not teach or suggest “a single computer system emulating a server and a client, said [single] computer executing server code and also executing client code.” However, the Examiner has taken the position, unsupported by the references of record, that Fletcher can be modified to include such limitations without affecting the performance of the Fletcher system. There is no teaching or suggestion of such a modification in Fletcher. In fact Fletcher teaches away from a single computer system emulating a server and a client because Fletcher teaches monitoring communication performance *in a communication network comprising communication systems communicatively coupled to each other with communication equipment. Fletcher*, Abstract; col. 3, lines 23-26; col. 3, lines 35-38; col. 6, lines 35-40. *Fletcher teaches both a client computer system and a server computer system in the communication network. Fletcher*, col. 5, line 57 – col. 8, line 4; and FIGs. 2-4. Thus, contrary to the present invention, Fletcher uses separate computer systems for the client and the server.

The Examiner further states, on pages 3-4 of the Office Action, that “Yu discloses a virtual network mechanism that allows a single host system to emulate multiple server and client processes, allowing data to be passed between said processes, and executing server and client code in the same said host system.” Applicant respectfully disagrees.

Yu discloses “a method and system for executing application programs which share a common communications protocol stack to utilize well-known port addresses for designating well-known application programs accessible by client application programs on a remote host system which is transparent to the remote system and requires minimal change to the host system thereby facilitating debugging, modifying and maintaining of such application programs.” *Yu*, col. 2, lines 55-64. Yu does not appear to teach Applicants’ element of “a single computer system emulating a server and a client, said computer executing server code and also executing client code. Instead, Yu teaches systems that share a single protocol stack on the same host system; multiple processing units running different copies of the same operating system and sharing the same protocol stack; and different operating systems running on the same host system sharing the same protocol stack. According to the sections of Yu cited by the Examiner, Yu teaches that server processes are run on a remote system. *Yu*, col. 5, lines 8-25. The Examiner, on page 14 of the Office Action, states that “Yu discloses that there is no requirement that the emulated systems be located in a physically separate computer system (Yu – Column 5 Lines 15-20).” The Examiner further states that “Yu disclosed a single computer system emulating a server and a client.”

Applicants respectfully disagree. The section of Yu cited by the Examiner, *Yu*, col. 5, lines 15-20, discloses an FTP services application program that permits the

transfer of files from one system to another. *Yu*, col. 5, lines 15-16. In fact, the paragraph in which this section is found discloses an interactive user on a client system starting a login session on a remote system. *Yu*, col. 5, lines 12-13. The passage goes on to state that “[i]n operation, the interactive user invokes an FTP client process on the local system. The client process establishes a connection with an FTP server process on the remote system using TCP.” *Yu*, col. 5, lines 18-22. Thus, the section of *Yu* cited by the Examiner does not disclose a single computer system emulating a server and a client. Instead, *Yu* discloses a local system and a remote system in which a client process is run on the local system and a server process is run on the remote system. *Yu*, col. 5, lines 8-26.

Thus, neither Fletcher nor *Yu*, separately or in combination, teach or suggest Applicants’ invention as recited in independent claims 1, 3, 9, 11, and 17. For at least the reasons stated above, claims 1, 3, 9, 11, and 17, and the claims that depend therefrom (claims 2, 23-24, and 29; 4-8 and 30; 10 and 25-26; 12-16; and 18-22, respectively) are patentable over the cited references of Fletcher and *Yu*.

The Examiner, on page 6 of the Office Action, has rejected claims 7, 15, and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,269,401 to Fletcher *et al.* (hereinafter “Fletcher”) in view of U.S. Patent No. 5,636,371 to *Yu* as applied to claims 1-6, 9-14, and 17-20 above, further in view of U.S. Patent Application Publication No. 2001/0056456 to Cota-Robles. Applicants respectfully traverse this rejection.

Claims 7, 15, and 21 depend from independent claims 3, 11, and 17, respectively, and are patentable over Fletcher and *Yu* for at least the reasons stated above.

Furthermore, Cota-Robles does not teach or suggest the features missing from Fletcher and Yu. For at least the reasons stated above, claims 7, 15, and 21 are patentable over Fletcher, Yu, and Cota-Robles.

The Examiner, on page 7 of the Office Action, has rejected claims 8, 16, and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,269,401 to Fletcher *et al.* (hereinafter "Fletcher") in view of U.S. Patent No. 5,636,371 to Yu, further in view of U.S. Patent Application Publication No. 2001/0056456 to Cota-Robles. Applicants respectfully traverse this rejection.

Claims 8, 16, and 22 depend from independent claims 3, 11, and 17, respectively, and are patentable over Fletcher and Yu for at least the reasons stated above. Furthermore, Cota-Robles does not teach or suggest the features missing from Fletcher and Yu. For at least the reasons stated above, claims 8, 16, and 22 are patentable over Fletcher, Yu, and Cota-Robles.

The Examiner, on page 9 of the Office Action, has rejected claims 23-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,269,401 to Fletcher *et al.* (hereinafter "Fletcher") in view of U.S. Patent No. 5,636,371 to Yu, further in view of U.S. Patent Application Publication No. 2001/0056456 to Cota-Robles. Applicants respectfully traverse this rejection.

Claims 23-24 and 25-26 depend from independent claims 1 and 9, respectively, and are patentable over Fletcher and Yu for at least the reasons stated above. Furthermore, Cota-Robles does not teach or suggest the features missing from Fletcher and Yu. For at least the reasons stated above, claims 23-24 and 25-26 are patentable over Fletcher, Yu, and Cota-Robles.



Independent claim 27 includes similar elements as recited in independent claims 1, 3, 9, 11, and 17, and thus, is patentable over Fletcher and Yu for at least the reasons stated above. Furthermore, Cota-Robles does not teach or suggest the features missing from Fletcher and Yu. For at least the reasons stated above, claim 27, and the claim that depends therefrom (claim 28) are patentable over Fletcher, Yu, and Cota-Robles.

Thus, for at least the foregoing reasons, Applicants respectfully submit that independent claims 1, 3, 9, 11, 17, and 27, and the claims that depend therefrom (claims 2, 23-24, and 29; 4-8 and 30; 10 and 25-26; 12-16; 18-22; and 28), respectively, are patentable over Fletcher and Yu or Fletcher, Yu, and Cota-Robles separately or in combination. Applicants respectfully submit that the Examiner erred in rejecting claims 1-30 based on Fletcher and Yu or Fletcher, Yu, and Cota-Robles. Applicants respectfully request that the Final Office Action be reviewed and that the review result in the withdrawal of the finality of the Office Action dated May 12, 2006

Respectfully submitted  
Intel Corporation

Dated: August 14, 2006

/Crystal D. Sayles, Reg. No. 44,318/  
Crystal D. Sayles  
Senior Attorney  
Intel Americas, Inc.  
(202) 986-3179

c/o Blakely, Sokoloff, Taylor & Zafman, LLP  
12400 Wilshire Blvd., Seventh Floor  
Los Angeles, CA 90025-1026

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:	
Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450	
On: <u>August 14, 2006</u>	
Signature: <u>Julie Dussault</u>	<u>August 14, 2006</u>
Julie Dussault	Date